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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/090,282	03/04/2002	Kazuo Ogasa	02127C/HG	6582
1933	7590	02/03/2004	EXAMINER	
FRISHAUF, HOLTZ, GOODMAN & CHICK, PC 767 THIRD AVENUE 25TH FLOOR NEW YORK, NY 10017-2023			SHEEHAN, JOHN P	
			ART UNIT	PAPER NUMBER
			1742	

DATE MAILED: 02/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/090,282

Applicant(s)

OGASA, KAZUO

Examiner

John P. Sheehan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-76 is/are pending in the application.
- 4a) Of the above claim(s) 45-76 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Preliminary Amendment***

The Examiner acknowledges receipt of the Preliminary Amendment submitted January 14, 2004.

### ***Election/Restrictions***

1. Applicant's election without traverse of Group I claims 1 to 44 in the response submitted October 21, 2003 is acknowledged.

### ***Specification***

2. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 2, 7, 12, 17, 22, 27, 32, 37 and 42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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I. Claims 2, 7, 12, 17, 22, 27, 32, 37 and 42 are in definite in that it is not clear whether the limitation, "in a range of not less than 50 ppm but less than 15,000 ppm in total" (for example see claim 2, the last 2 lines) applies to the Gd as in independent claim 1 or to the "at least one element selected from the group consisting... boron" (for example claim 2, lines 4 to 6).

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 2 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by each of Uchiyama et al. (Uchiyama, US Patent No. 6,123,786) or Ogasa (US Patent No. 6,063,213).

Each of these references teaches at least one specific example alloy having a composition that is encompassed by the applicants' claims (Uchiyama, columns 3 and 4, Table 2, Sample 19, columns 5 and 6, Table 3, Sample 26 and Table 5, Sample 43 and Ogasa, columns 7 and 8, Table 1, Alloy No. 7 and Table 2, Alloy Nos. 2, 10, 11 and 13 to 18). In view of these specific alloy compositions Uchiyama and Ogasa are considered to anticipate claims 1, 2 and 5.

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***Claim Rejections - 35 USC § 102/103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 3 and 41 to 44 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over each of Uchiyama et al. (Uchiyama, US Patent No. 6,123,786) or Ogasa (US Patent No. 6,063,213).

As set forth in the rejection under 35 USC 102 based on these references, each of these references teaches at least one specific example alloy having a composition that is encompassed by the applicants' claims (Uchiyama, columns 3 and 4, Table 2, Sample 19, columns 5 and 6, Table 3, Sample 26 and Table 5, Sample 43 and Ogasa, columns 7 and 8, Table 1, Alloy No. 7 and Table 2, Alloy Nos. 2, 10, 11 and 13 to 18).

The claims and the references differ in that the references do not teach hardness values and Young's modulus values recited in applicants' claims.

However, one of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because the specific example alloys taught by the references have compositions that are encompassed by the instant claims and therefore the alloys taught by the references would be expected to possess all the same properties as recited in the instant claims, *In re Best*, 195 USPQ, 430 and MPEP 2112.01.

"Where the claimed and prior art products are identical

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or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established, In re Best, 195 USPQ 430, 433 (CCPA 1977). 'When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.' In re Spada, 15 USPQ2d 655, 1658 (Fed. Cir. 1990). Therefore, the prima facie case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product. In re Best, 195 USPQ 430, 433 (CCPA 1977)." (emphasis added by the Examiner) see MPEP 2112.01.

### ***Claim Rejections - 35 USC § 103***

9. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over each of Uchiyama et al. (Uchiyama, US Patent No. 6,123,786) or Ogasa (US Patent No. 6,063,213).

As set forth in the rejection under 35 USC 102 based on these references, each of these references teaches at least one specific example alloy having a composition that is encompassed by the applicants' claims (Uchiyama, columns 3 and 4, Table 2, Sample 19, columns 5 and 6, Table 3, Sample 26 and Table 5, Sample 43 and Ogasa, columns 7 and 8, Table 1, Alloy No. 7 and Table 2, Alloy Nos. 2, 10, 11 and 13 to 18).

The claims and the references differ in that the references do not teach hardness values and Young's modulus values recited in applicants' claims nor do the references teach the process step of working the alloy as recited in product by process claim 4.

However, one of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because the specific example alloys taught by the references have compositions that are encompassed by the instant claims and therefore the alloys taught by the references would be expected to possess

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all the same properties as recited in the instant claims, In re Best, 195 USPQ, 430 and MPEP 2112.01.

"Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established, In re Best, 195 USPQ 430, 433 (CCPA 1977). 'When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.' In re Spada, 15 USPQ2d 655, 1658 (Fed. Cir. 1990). Therefore, the prima facie case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product. In re Best, 195 USPQ 430, 433 (CCPA 1977)." (emphasis added by the Examiner) see MPEP 2112.01.

Regarding the process limitation recited in claim 4, it is the Examiner's position that, one of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because the process limitation recited in product by process claim 4 does not necessarily lend patentability to the claimed product, MPEP 2113.

### ***Claim Rejections - 35 USC § 103***

10. **NOTE:** The Examiner's reasoning regarding each of the following rejections is the same, therefore it will be stated once after all the statements of the rejections have been set forth.

11. Claims 21 to 25 and 41 to 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over each of Uchiyama et al. (Uchiyama, US Patent No. 6,123,786) or Ogasa (US Patent No. 6,063,213).

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Each of the references teaches an alloy having a composition that overlaps the alloy composition recited in the instant claims (see Uchiyama, column 1, line 43 to column 2, line 7 and Ogasa, column 2, lines 43 to 56 and line 66 to column 3, line 5).

12. Claims 1 to 5, 16 to 20 and 36 to 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over each of Japanese Patent Document No. 8-31253 (Japan '253) or Japanese Patent Document No. 11-126788 (Japan '788, each these references was cited in the IDS submitted April 4, 2003).

Each of the references teaches an alloy having a composition that overlaps the alloy composition recited in the instant claims (See the Abstract of each of these references).

13. Claims 1 to 10, 26 to 30 and 41 to 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muragishi et al. (Muragishi, US Patent No. 5,518,691 cited in the IDS submitted March 4, 2002).

Muragishi teaches an alloy having a composition that overlaps the alloy composition recited in the instant claims (Abstract and column 2, lines 15 to 28 and 48 and 49).

14. Claims 11 to 15, 21 to 25 and 36 to 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent Document No. 2000-034529 (Japan '529, cited in the IDS submitted March 4, 2002).

Japan '529 teaches an alloy having a composition that overlaps the alloy composition recited in the instant claims (Abstract).



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15. Claims 6 to 10 and 26 to 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent Document 63-020426 (Japan '426, cited in the IDS submitted March 4, 2002).

Japan '426 teaches an alloy having a composition that overlaps the alloy composition recited in the instant claims (Abstract).

16. Claims 31 to 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chemical Abstracts 124:63442 (Chem '442, cited in the IDS submitted March 4, 2002).

Chem '442 teaches an alloy having a composition that overlaps the alloy composition recited in the instant claims (Abstract).

In each of the rejections set forth immediately above under the heading, "Claim Rejections - 35 USC § 103" the claims and the references differ in that the references do not teach the exact same alloy proportions or hardness values and Young's modulus values recited in applicants' claims.

However, one of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because the alloy proportions taught by each of the references overlap the instantly claimed proportions and therefore are considered to establish a prima facie case of obviousness. It would have been obvious to one of ordinary skill in the art to select any portion of the disclosed ranges including the instantly claimed ranges from the ranges disclosed in the prior art reference, particularly in view of the fact that;

"The normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of

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percentages", In re Peterson 65 USPQ2d 1379 (CAFC 2003).

Also, In re Geisler 43 USPQ2d 1365 (Fed. Cir. 1997); In re Woodruff, 16 USPQ2d 1934 (CCPA 1976); In re Malagari, 182 USPQ 549, 553 (CCPA 1974) and MPEP 2144.05.

Regarding the hardness and Young's modulus values recited in the claims, it is the Examiner's position that because the alloys taught by the references have compositions that overlap the instantly claimed alloys, one of ordinary skill in the art at the time the invention was made would have expected the alloys taught by the references to possess all the same properties as recited in the instant claims, In re Best, 195 USPQ, 430 and MPEP 2112.01.

"Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established, In re Best, 195 USPQ 430, 433 (CCPA 1977). 'When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.' In re Spada, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Therefore, the prima facie case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product. In re Best, 195 USPQ 430, 433 (CCPA 1977)." (emphasis added by the Examiner) see MPEP2112.01.

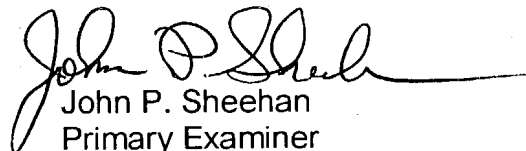
### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Sheehan whose telephone number is (571) 272-1249. The examiner can normally be reached on T-F (6:45-4:30) Second Monday Off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.

  
John P. Sheehan  
Primary Examiner  
Art Unit 1742

jps